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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,966	07/17/2003	David Solow-Cordero	061030-0023-US	2041
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MORGAN, LEWIS & BOCKIUS LLP (SF) 2 PALO ALTO SQUARE 3000 El Camino Real, Suite 700 PALO ALTO, CA 94306				
			EXAMINER GEMBEH, SHIRLEY V	
			ART UNIT 1614	PAPER NUMBER

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/621,966	Applicant(s) SOLOW-CORDERO ET AL.	
	Examiner Shirley V. Gembah	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,18,19, 21-27, 29-32 and 34-64 is/are pending in the application.
 4a) Of the above claim(s) 13,18,19,26,27,29-32,38-50,63 and 64 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,34-37 and 51-62 is/are allowed.
- 6) ☒ Claim(s) 4-12 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of claims

Claims 1-2, 4-12, 21- 25, 34-37 and 51-62 are examined.

Claims 63 and 64 are withdrawn from examination. In the restriction requirement dated 8/25/05. Newly submitted claims 63-64 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Applicant was requested to elect a single disclosed patentable specie. Applicant elected in the reply dated 10/27/05, Applicants elected the species "treating vasoconstriction" and "structure with formula (I)" Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election was been treated as an election without traverse (MPEP § 818.03(a)).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 63 and 64 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-2, 4-12, 21-25, 34-37 and 51-62 are examined.

Claims 13, 18-19, 26-27, 29-32, 38-50 and 63-64 are withdrawn from further consideration.

Claims 3, 14-17, 20, 28 and 33 are cancelled.

Claims 1-2, 5-12, 18, 21, 26-27, 29-32, 34-37, 42, 44, 47 and 48 are amended.

With regards to claims 63 and 64 directed to formulae II and II is unpersuasive. Accordingly Applicant upon the restriction requirement was asked to elect a single disclosed species and claims that read upon the disclosed specie. Applicant elected formula I with vasoconstriction as the disease. Adding claims with formula II or III will constitute new search. The restriction requirement is Final.

The response filed **July 31, 2006** presents remarks and arguments to the office action mailed **January 26, 2006**. Applicants' request for reconsideration of the rejection of claims in the last office action has been considered.

Applicants' arguments, filed **July 31, 2006**, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Allowable Subject Matter

Claims 1-2, 34-37 and 51-62 appear to be free of art and are allowed.

Maintained Claim Rejections - 35 USC § 112

Applicants' argument that "at least about" is not indefinite is unpersuasive. As stated in the office action of record it includes element not discussed. The rejection is maintained and hereby repeated.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 5-12 and 22-23 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-12 and 22-23 the phrase "at least about" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "at least about"), thereby rendering the scope of the claim(s) unascertainable because it is not apparent which term is the limiting term. The "at least" in this instance indicates the amount must be ≥ 200 but the "about" indicates the amount can be less than 200. See MPEP § 2173.05(d).

Claim 21 is also rejected, the phrase "between about" renders the claim indefinite for the reasons paralleling the above discussion of "at least" "about".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-12 and 21-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Applicant has not conveyed possession of the invention with reasonable clarity to one skilled in the art. In particular, Applicant has not provided a description of the structure of a representative number of derivative compounds nor a description of the chemical and/or physical characteristics of a representative number of compounds nor a description of how to obtain a representative number of specific compounds. For example claim 4 requires that the claimed modulator utilized must be an antagonist however, in claims 5-12 and 21-25 recites certain properties of a modulator. Although, certain inhibitory compounds are described such as that on page 54 of the specification however, lacks sufficient written basis for the unspecified characteristics of claims 4-12 and 21-25.

A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) (a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not "reasonably lead" those skilled in the art to any particular species); *In re Ruschig*, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembeh whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SVG
1/21/06

Ardin H. Marschel 12/9/06
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER